

In re application of KRAMER, M.  
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### REMARKS

The amendment filed with the Request for Continued Examination under 37 C.F.R. 1.114 has been entered. Claims 2-6, 8-11, 17, 18, 20 and 24 are pending.

Claims 2-6, 8-11, 17, 18, 20 and 24 have been rejected in the present application.

Claims 4-7, 18-20 have been cancelled without prejudice or disclaimer. Applicants reserve the right to pursue the cancelled subject matter in one or more Continuation or Divisional applications.

Claim 2 has been amended. No new matter has been added by virtue of these amendments and their entry is respectfully requested.

Any amendments and cancellation of the claims are not to be construed as an acquiescence to any of the rejections/objections set forth in the instant Office Action, and were done solely to expedite prosecution and allowance of the application. Applicants reserve the right to pursue the claims as originally filed, or substantially similar claims, in this or one or more continuation patent applications.

### *Claim Objections*

The Examiner states that should claim 3 be found allowable, claim 4 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate. In response, Applicants have cancelled claim 4.

Claim 5 is objected to because it is grammatically incorrect. The word "with" has been deleted.

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Claim 18 has been objected to due to grammatical errors. Applicants have amended the claim to delete the second "Method" from the claim.

Any amendments and cancellation of the claims are not to be construed as an acquiescence to any of the rejections/objections set forth in the instant Office Action, and were done solely to expedite prosecution and allowance of the application. Applicants reserve the right to pursue the claims as originally filed, or substantially similar claims, in this or one or more continuation patent applications.

***Claim Rejections under 35 U.S.C. § 112.***

Claims 2-6, 8-11, 17, 18, 20 and 24 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully traverse. However, to compact and expedite prosecution, Applicants have amended the claims. This is not to be construed as surrender of any subject matter and Applicants reserve the right to pursue these claims and subject matter in one or more Continuations or Divisional applications.

The Examiner further rejects the claims based on "conventional, low or high stringency conditions." Applicants submit that support for these conditions is found in paragraph [009], page 3 of the instant specification. One of skill in the art can identify any sequence that hybridizes to SEQ ID NO's: 1 or 4 based on the disclosure and no undue experimentation would be required.

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In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

Claim 18 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully traverse. However, in order to expedite and compact prosecution, Applicants have cancelled claim 18. This cancellation is solely for prosecution purposes and is not meant to be construed as surrender of subject matter. Applicants retain the right to pursue the subject matter in one or more Continuations or Divisional applications.

In view of cancellation of claim 18, the Examiner's rejection is moot.

***Claim Rejections under 35 U.S.C. § 102***

Claims 2, 3, 4 and 17 were rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention.

The Examiner raises this rejection based upon a public use or sale of the invention because the cited reference Boehringer Mannheim Catalog 1997, page 95 shows that random hexanucleotides were available for sale as early as 1997. Independent claim 2 (claims 3 and 5 being dependent claims to claim 2) has been amended in order to overcome this rejection. Claim 2 is directed to oligonucleotides which hybridize to SEQ ID NO: 1 and SEQ ID NO: 4 under specified hybridization conditions. See, for example paragraphs [0006]-[0009]. That is, an oligonucleotide that will only hybridize under high stringent conditions would mean that the homology between the oligonucleotide would not encompass hexanucleotides as cited in the Boehringer Mannheim Catalog.

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Claims 2, 3, 4 and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mierendorf *et al.* (U.S. Patent 5,629,179).

Applicants respectfully traverse. However, in order to compact and expedite prosecution, Applicants have amended the claims. These amendments are deemed to overcome the Examiner's rejections.

However, Applicants maintain that Mierendorf does not teach or disclose each and every claim limitation of the instant invention, for example SEQ ID NO's: 1 and 4. Mierendorf *et al.*, teach the generation of random primers. Mierendorf *et al.*, do not teach or disclose which random sequences will hybridize to SEQ ID NO's: 1 and 4; which conditions would be necessary to achieve hybridization to SEQ ID NO: 1 and SEQ ID NO: 4. Therefore, undue experimentation would be required. By reading Mierendorf *et al.*, one of ordinary skill in the art would not arrive at the instant invention. Applicants submit that Mierendorf *et al.*, do not teach each and every limitation of claims 2 and 3.

In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

***Claim Rejections Under 35 U.S.C. § 112, First Paragraph***

Claims 2-6, 8-11, 17, 18, 20 and 24 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

The Examiner has rejected these claims as a "New matter rejection." Applicants respectfully traverse. However, in order to compact and expedite prosecution, Applicants have amended the claims so as not to refer to "said partial sequence comprising more than 8

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nucleotides", under conventional stringent hybridization conditions", and "more than 8 and up to 25 nucleotides."

In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

### CONCLUSION

In view of the foregoing, reconsideration and withdrawal of all rejections and allowance of the application with claims 2-6, 8-11, 17, 18, 20 and 24 are respectfully solicited. The amended claims set forth, herein, are merely to expedite prosecution and allowance of the application and is not to be construed as surrender of any subject matter in the instant application. Applicants hereby reserve the right to pursue the subject matter of the canceled claims in one or more continuations, continuation-in-part or divisional patent applications.

If there are any remaining issues or the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at telephone number shown below.

Although, Applicants believe that no further extensions of time (beyond the one month petition) are required with submission of this paper, Applicants request that this submission also be considered as a petition for any extension of time if necessary. The Commissioner for Patents and Trademarks is hereby authorized to charge the amount due for any retroactive extensions of time and any deficiency in any fees due with the filing of this paper or credit any overpayment in any fees paid on the filing or during prosecution of this application to Deposit Account No. 50-0951.

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Respectfully submitted,

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